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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,759	01/22/2004	Brian Mathur	LEX-0476-USA	3859

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LEXICON GENETICS INCORPORATED  
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THE WOODLANDS, TX 77381-1160

EXAMINER

PAK, YONG D

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/762,759	Applicant(s) MATHUR ET AL.	
	Examiner Yong D. Pak	Art Unit 1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 4-8 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This application is a continuation of 09/707,121, issued as US 6,720,173.

The preliminary amendment filed on November 7, 2005, canceling claims 1-3 and adding claims 4-8, has been entered.

Claims 4-8 are pending.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 4-6, drawn to a gene delivery system comprising a polypeptide of SEQ ID NO:1, classified in class 435, subclass 455.
- II. Claim 7, drawn to a polypeptide comprising SEQ ID NO:2, classified in class 530, subclass 194.
- III. Claim 8, drawn to antibody against the polypeptide of SEQ ID NO:2, classified in class 530, subclass 387.9..

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are patentably distinct products.

The gene delivery system of group I and the polypeptides of groups II-III are patentably distinct inventions for the following reasons. Polypeptides, are composed of amino acids and gene delivery systems comprises of polynucleotides, which are composed of purine and pyrimidine units; any relationship between a polynucleotide and polypeptide is dependent upon the information provided by the nucleic acid sequence open reading frame as it corresponds to the primary amino acid sequence of

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the encoded polypeptide. While a polypeptide of group I can be made by methods using some, but not all, of the polynucleotides that fall within the scope of group I, it can also be recovered from a natural source using biochemical means. For instance, the polypeptide can be isolated using affinity chromatography. For these reasons, the inventions of groups I-III are patentably distinct.

Furthermore, searching the inventions of groups I-III together would impose a serious search burden. In the instant case, the search of the polypeptides and polynucleotides are not coextensive. The inventions of groups I-III have a separate status in the art as shown by their different classifications. In cases such as this one where descriptive sequence information is provided, the sequences are searched in appropriate databases. There is search burden also in the non-patent literature. Prior to the concomitant isolation and expression of the sequence of interest there may be journal articles devoted solely to polypeptides which would not have described the polynucleotide. Searching, therefore is not coextensive.

The polypeptide of group II and the antibody of group III are patentably distinct for the following reasons:

While the inventions of both group II and group III are polypeptides, in this instance the polypeptide of group II is a single chain molecule that functions as an enzyme, whereas the polypeptide of group III encompasses antibodies. Thus the polypeptide of group II and the antibody of group III are structurally distinct molecules; any relationship between a polypeptide of group II and an antibody of group III is dependent upon the correlation between the scope of the polypeptides that the antibody

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binds and the scope of the antibodies that would be generated upon immunization with the polypeptide.

In this case, the polypeptide of group II is a large molecule which contains potentially hundreds of regions to which an antibody may bind, whereas the antibody of group III is defined in terms of its binding specificity to a small structure within SEQ ID NO: 2. Thus immunization with the polypeptides of group II would result in the production of antibodies outside the scope of group III.

Furthermore, searching the inventions of group II and group III would impose a serious search burden. The inventions have a separate status in the art as shown by their different classifications. A polypeptide and an antibody which binds to the polypeptide require different searches. An amino acid sequence search of the full-length protein is necessary for a determination of novelty and unobviousness of the protein. However, such a search is not required to identify the antibodies of group III. Furthermore, antibodies which bind to an epitope of a polypeptide of group II may be known even if a polypeptide of group II is novel. In addition, the technical literature search for the polypeptide of group II and the antibody of group III are not coextensive, e.g., antibodies may be characterized in the technical literature prior to discovery of or sequence of their binding target.

The polynucleotide of group I and the antibody of group III are patentably distinct for the following reasons. Polypeptides, such as the antibody of group III which are composed of amino acids, and polynucleotides, which are composed of nucleic acids, are structurally distinct molecules; any relationship between a polynucleotide and

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polypeptide is dependent upon the information provided by the nucleic acid sequence open reading frame as it corresponds to the primary amino acid sequence of the encoded polypeptide. In the present claims, a polynucleotide of group I will not encode an antibody of group III, and the antibody of group III cannot be encoded by a polynucleotide of group I. Therefore the antibody and polynucleotide are patentably distinct.

The antibody and polynucleotide inventions have a separate status in the art as shown by their different classifications. Furthermore, searching the inventions of group III and group I would impose a serious search burden since a search of the polynucleotide of group I is would not be used to determine the patentability of an antibody of group III, and vice-versa.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 571-272-0935. The examiner can normally be reached 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Yong D. Pak  
Patent Examiner 1652



Manjunath Rao  
Primary Patent Examiner 1652